

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Seth A. Foerster et al.  
Application No. :  
Filed :  
Title : METHODS AND DEVICES FOR  
DEFINING AND MARKING TISSUE  
  
Group/Art Unit :  
Examiner :  
  
Docket No. : END-777

Honorable Commissioner of Patents  
Washington, D.C. 20231

**PRELIMINARY AMENDMENT**

Dear Sir:

Please amend the above-identified application as follows:

**In the Title:**

Please amend the title of the above-identified application to be: Methods for  
Defining and Marking Tissue

**In the Claims:**

Please Cancel Claims 1-45

Please Insert the following Claims:

46. A method of marking a particular tissue area within a human body to identify that particular tissue area for a later diagnostic or therapeutic procedure, said method comprising the steps of:

a) inserting a marker element applier into an incision in said body, wherein said marker element applier comprises:

an introducer comprising:

a closed distal end;

a tube, wherein said tube comprises:

a lumen;

an axial opening at a proximal end of said tube;

a side exit port adjacent a distal end of said tube;

a closed distal end;

a proximal opening;

at least one discrete marker element positioned in said tube;

a shaft moveably positioned in said lumen, wherein a proximal end of said shaft extends from said axial opening;

b) positioning said side exit port adjacent the particular tissue area to be marked; and

c) ejecting said at least one marker element from said side exit port into said tissue to be marked, wherein said marker element is positioned in said tube distal to said shaft and said at least one marker element is forced out said side exit port by applying compressive force to said proximal end of said shaft.

47. A method of depositing a marker element within tissue, said method comprising the steps of:

a) providing a marker instrument including a tube having a lumen, as side exit port adjacent to a distal end of said tube, a distal portion of said lumen connecting said lumen to said side exit port and a plurality of marker elements disposed within said lumen, including a first marker element at a proximal end of said plurality of marker elements and a second marker element at a distal end of said plurality of marker elements;

b) inserting said tube into a body until said side exit port is proximate to the tissue to be marked; and

c) forcing said second marker element against said distal portion of said lumen and out said side exit port by applying a compressive force to a proximal end of said first marker element.

48. A method of depositing a marker element in tissue, said method comprising the steps of:

a) positioning a distal end of a marker element applier adjacent a first region of tissue to be marked; and

b) applying a compressive force to a marker element disposed within said marker element applier to force said marker element out a side exit port in said marker element applier.

49. A method according to Claim 48 wherein said method further comprises the step of:

c) positioning said distal end of said marker element applier adjacent a second region of tissue to be marked; and

d) applying a compressive force to a second marker element disposed within said marker element applier to force said marker element out said exit port.

REMARKS / ARGUMENTS

Attached hereto is a marked-up Appendix version of the changes made to the title by the current amendment. The attached pages are captioned: "Appendix: Version with Markings to Show Changes Made".

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
Johnson & Johnson

By:   
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## **Appendix: Version with Markings to Show Changes Made**

### **In The Title**

\_\_\_\_\_ Methods and Devices for Defining and Marking Tissue